

U.S. Serial No. 10/045,628
Amendment to Office Action dated May 4, 2004

Remarks/Arguments

The preceding amendments and following remarks are submitted in response to the non-final Office Action mailed May 4, 2004, setting a three-month shortened statutory period for response ending August 4, 2004. With this Amendment, Applicants have cancelled claims 36-41, and have added newly presented claims 53-77, which Applicants submit are readable upon the elected group and species. Reconsideration, examination, and allowance of all pending claims are respectfully requested.

Claim Objections

In paragraph 2 of the Office Action, the Examiner objected to claim 36, stating that the recitation "an elongated shaft" contained in line 4 of that claim should read "the elongated shaft". In response to this objection, Applicants note that claims 36-41 have been cancelled, thereby rendering the Examiner's object moot.

35 U.S.C. § 102 Rejections

On page 3 of the Office Action, the Examiner rejected claims 36 and 38-41 under 35 U.S.C. § 102(b) as being anticipated by *Khosravi et al.* (U.S. Patent No. 6,129,739). Furthermore, on page 4 of the Office Action, the Examiner rejected claims 36-41 under 35 U.S.C. § 102(e) as being anticipated by *Tsugita* (U.S. Patent No. 6,142,987).

With this Amendment, claims 36-41 have been cancelled, and claims 53-77 have been added, which Applicants respectfully assert are patentable over the *Khosravi et al.* and *Tsugita* references. Newly presented claim 53 recites:

53. (New) A filter exchange system, comprising:
a filter assembly including a filter member coupled to an elongated wire;
an exchange sheath having a proximal end and a distal end, the exchange sheath defining a guidewire sheath and a filter sheath;

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the guidewire sheath having a proximal end, a distal end, a length, and a guidewire lumen adapted to receive a guidewire therethrough, said guidewire lumen including an open discontinuous portion exposing at least a portion of the length of the guidewire sheath; and

the filter sheath having a proximal end, a distal end, and a filter lumen adapted to receive at least a portion of the filter member therein.

Unlike the filter exchange system recited in claim 53, neither the *Khosravi et al.* and *Tsugita* references disclose or suggest, among other elements, a guidewire sheath including a guidewire lumen having an open discontinuous portion exposing at least a portion of the length of the guidewire sheath, and a filter sheath including a filter lumen adapted to receive at least a portion of a filter member therein. In *Khosravi et al.*, the elongated shaft (40) depicted in Figures 5A-5d does not include a separate guidewire lumen and filter lumen. Instead, as can be seen in Figure 5A, the delivery sheath (40) appears to define a single lumen that can be used to contain both a filter sac (28) and a guidewire (22).

The *Tsugita* reference similarly fails to disclose each and every element of claim 53. In Figures 1J, 1I, and 1K of *Tsugita* cited by the Examiner, the rapid exchange catheters do not include a guidewire sheath including a guidewire lumen having an open discontinuous portion exposing at least a portion of the guidewire sheath, and a filter sheath including a filter lumen adapted to receive at least a portion of a filter member therein. While the *Tsugita* reference does suggest the use of an open discontinuous portion in at least some embodiments (see e.g. Figure 1), nothing in that reference appears to disclose or suggest an exchange sheath that includes a separate guidewire lumen and filter lumen as well as an open discontinuous portion on the guidewire lumen. Accordingly, Applicants respectfully assert that claim 53 is patentable over the cited prior art.

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Because claim 53 is allowable, claims 54-65 are also allowable for the reasons stated above, and since they add other significant elements to distinguish them from the cited prior art.

With this Amendment, claims 66-77 have also been added. For the reasons cited above and for other reasons, Applicants respectfully assert that claims 66-77 are also patentable over the cited prior art.

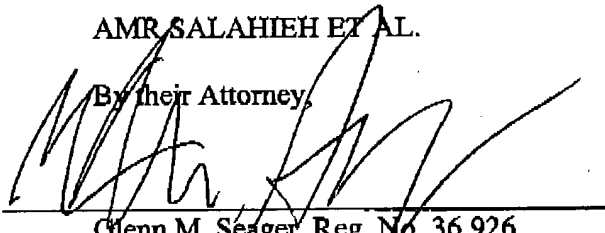
In view of the foregoing, Applicants submit that all pending claims are in condition for allowance. Reexamination and reconsideration are respectfully requested. If the Examiner would like to discuss the Application or its examination, please contact the undersigned at (612) 677-9050.

Respectfully submitted,

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By their Attorney,

Date: Aug. 30, 2004


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